

Remarks

Claims 1, 5, 9, 13, 17 and 21 are pending. Reconsideration is requested in light of the following.

Concurrently filed with this paper is a "Request for Reconsideration", or the Request, as to the finality of the pending rejection. In sum, the Request seeks relief from the finality of the pending rejection as the instant action is the first citation of "well known art", i.e., the knowledge of one of ordinary skill in the art.

35 U.S.C. §103(a)

Claims 1, 5, 9, 13, 17 and 21 are rejected under 35 U.S.C. §102(e) as being obvious over U.S. Patent No. 6,609,106 to Robertson (hereinafter "Robertson") in view of "well known art". Applicants traverse the rejection. The pending rejection is improper as (1) the asserted "well known art" is not really "well known", (2) the asserted modification does not take the primary reference as a whole and (3) the asserted motivation to combine fails to achieve the asserted purpose of enhancing the security system.

Claim 1 in-part recites a method for use in a graphical user interface configured to support a login operation, the method comprising:

- while conditions allow for the reception of the user password input and it is determined that there has been a failure to operatively receive the user password input for the login operation, then automatically displaying reminder information associated with the user input field through a non-modal mechanism within the graphical user interface, wherein the display of the reminder information is removed upon receipt of an input via the at least one user input field.

The Examiner is correct that Robertson fails to teach wherein the display of the reminder information is removed upon receipt of an input via the at least one user input field. The Examiner is incorrect that the foregoing teaching would have been within the knowledge of one of ordinary skill in the art.

As the Office is well aware, Applicants are required to seasonably challenge statements by the Office that are not supported on the record. *M.P.E.P. §2144.03*.

Further, Applicants note that "Official Notice" is to be limited to instances where the facts are "capable of instant and unquestionable demonstration as being well-known". M.P.E.P. §2144.03. This is not the present situation. First, in accordance with M.P.E.P. §904 it is presumed that a full search was conducted and this search is indicative of the prior art. The search failed to disclose a reference which would teach or suggest modifying the Robertson reference to achieve the presently recited subject matter wherein the display of the reminder information is removed upon receipt of an input via the at least one user input field. Consequently, the search revealed that the asserted substitution is not well-known and therefore is not entitled to be relied upon in order to reject the presently recited subject matter. If the Office is unable to provide such a reference, and is relying on facts based on personal knowledge, Applicants hereby request that such facts be set forth in an affidavit from the Examiner under 37 C.F.R. 1.104(d)(2) so Applicants may offer appropriate rebutting evidence.

Moreover, the asserted motivation to combine appears to be a classic case of hindsight as the asserted motivation is inconsistent with the teaching of Robertson on the whole, and fails to address why one of ordinary skill in the art, at the time of the invention, would have wanted to make the modification. Robertson, on the whole, teaches that the "hint" is displayed once the user has entered a valid user name, but has failed to enter the correct password. Providing a "hint" in Robertson allows a user to continue to view the "hint" (Robertson, FIG. 20C) as he/she enters the password (the goal in Robertson is to ensure a user is provided with ample opportunity to enter the correct password). Thus, in order to implement the Examiner's proposed modification, one would have ignore the purpose of providing the "hint", i.e., provide an opportunity for the user to enter the correct password.

The Examiner's "security enhancement" rationale is incorrect as in each case the "hint" is displayed. The mere fact that the prior art may be modified in

1 the manner suggested by the Examiner does not make the modification obvious
2 unless the prior art suggested the desirability of the modification. It is
3 impermissible to use the claimed invention as an instruction manual or 'template'
4 to piece together the teachings of the prior art so that the claimed invention is
5 rendered obvious. This court has previously stated that "[o]ne cannot use
6 hindsight reconstruction to pick and choose among isolated disclosures in the prior
7 art to deprecate the claimed invention." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d
8 1443 (Fed. Cir. 1992) quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596,
9 1600 (Fed. Cir. 1988). Removal of the pending rejection is requested and
10 allowance is earnestly solicited.

11 **Independent Claim 9** is allowable based on the same rationale as discussed
12 with respect to Claim 1. While the outstanding action treats Claims 1, 9 and 17
13 together, Claim 9 recites language which differs from that in Claim 1 and is
14 therefore separately patentable. In particular, Claim 9 in part recites,

15 • determining if there has been a failure to operatively receive the user
16 password input for the login operation while conditions allow for the reception of
17 the user input, wherein the failure is detected at least in part by failure to receive
18 the user password input for a given amount of time

19 Nowhere does Robertson teach this feature nor is the knowledge of one of
20 ordinary skill in the art, at the time of the invention was made, cited as correcting
21 this deficiency. To establish *prima facie* obviousness of a claimed invention, all
22 the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180
23 U.S.P.Q. 580 (C.C.P.A. 1974). See also *In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A.
24 1970). In the present case, the Office has failed to provide any rationale which
25 would obviate the recited matter, e.g., a situation in which a user fails to provide
any entry. The only possible teaching, Robertson, Col. 20, lines 40-53 (reproduced
below), fails to address the example situation in which no data is entered.
Robertson Col. 20, lines 40-53 only addresses an incorrectly entered password.

With regards to FIG. 13, if the Log On link 260 is selected, then the User/SP must first authenticate using the user interface dialog depicted in FIG. 20A. If the User/SP does not provide a valid username/password combination, then they will be shown either FIG. 20B or FIG. 20C, where the User/SP has the opportunity to try again. If the username is not valid, the User/SP will be shown FIG. 20B. Otherwise, if the username is valid, but the password is not, then the User/SP will be shown FIG. 20C, which adds the associated password hint for the given username. Also available on this screen is a button to have the Gift Registry system automatically email them their password. This comes in handy if they forget their password, but note that the system only sends the password to the email address of the profile associated with the given username. This is a standard practice in the industry.

If the User successfully logs on, they will be greeted with the User Main Page FIG. 21. On the User Main Page, there are buttons for performing the functions of a) Editing their Profile, b) Registering Reminders, c) Registering Occasions, d) Maintaining "Wish" lists, and e) User Discussion Groups.

As the outstanding Action fails to address the situation in which the failure is detected at least in part by failure to receive the user password input for a given amount of time, a *prima facie* case of obviousness does not exist. Removal of the pending rejection is requested and allowance is earnestly solicited.

Independent Claim 17 is allowable based on the same rationale as discussed with respect to Claim 1. While the outstanding action treats Claims 1, 9 and 17 together, Claim 17 recites language which differs from that in Claim 1 and is therefore separately patentable. In particular, Claim 17 in part recites,

- automatically display reminder information associated with the user input field through a non-modal mechanism as a hint balloon within the graphical user interface based on the failure to operatively receive the user password input

Nowhere does Robertson teach or suggest the utilization of a hint balloon. Further, the knowledge of one of ordinary skill in the art is not cited as correcting this deficiency in Robertson. Robertson is limited to providing an alternate screen display (Robertson, FIG. 20C) and does not suggest any other methodology for providing a hint to a user. The Office has failed to provide any assertion why one of ordinary skill in the art would know to (1) replace an alternate screen with a balloon and (2) would have sufficient motivation to make the modification. Thus, even if we accept the Examiner's argument, "It was well known that the graphical user interface displays a non-modal mechanism as a hint balloon instead a text

1 popup of is taught in the computer art because it is a design choice”, as true this
2 fails to provide any incentive for making the substitution. *Instant Action*, Page 4,
3 second full paragraph. Removal of the pending rejection is requested and
4 allowance is earnestly solicited.

5 **Claim 5** is pending a rejection under 35 U.S.C. §103(a) over Robertson in-
6 view of “well known art.” Applicants traverse the rejection. Claim 5 is allowable
7 based on its dependency from Claim 1 which is believed to be in a condition for
8 allowance. Applicants will not burden the record further. Removal of the pending
9 rejection is requested and allowance is solicited.

10 **Claim 13** is pending a rejection under 35 U.S.C. §103(a) over Robertson in-
11 view of “well known art.” Applicants traverse the rejection. Claim 13 is
12 allowable based on its dependency from Claim 9 which is believed to be in a
13 condition for allowance. Claim 13 recites different subject matter than that in
14 Claim 5 (asserted to be similar in scope) and is therefore separately patentable.
15 Applicants will not burden the record further. Removal of the pending rejection is
16 requested and allowance is solicited.

17 **Claim 21** is pending a rejection under 35 U.S.C. §103(a) over Robertson in-
18 view of “well known art.” Applicants traverse the rejection. Claim 21 is
19 allowable based on its dependency from Claim 17 which is believed to be in a
20 condition for allowance. Claim 21 recites different subject matter than that in
21 Claim 5 (asserted to be similar in scope) and is therefore separately patentable.
22 Applicants will not burden the record further. Removal of the pending rejection is
23 requested and allowance is solicited.


24 **Conclusion**

25 Claims 1, 5, 9, 13, 17 and 21 are in condition for allowance. Applicant
respectfully requests reconsideration and prompt issuance of the subject

1 application. If any issues remain that prevent issuance of this application, the
2 Examiner is urged to contact the undersigned attorney before issuing a subsequent
3 Action.

4 Respectfully Submitted,

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7 Dated: 12/19/6

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